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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,417	06/09/1999	MANUEL A. CORREA JR		6806

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,417

Applicant(s)

CORREA JR, MANUEL A.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 82-112 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 82-112 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/9/99 & 10/28/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The finality of the Office action mailed December 17, 2002 is hereby withdrawn and an action on the merits follows.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4.1 Claims 82, 85, 91, 93, 94, 97, 104 & 112, are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Bowen et al (5,011,069) or Elmlinger (5,248,082).

4.1.1 In regard to claim 82, 91, 93, 94, 97, 104 & 112, either Bowen et al ('069) or Elmlinger ('082) discloses a multiple layer/ply mailer, where the first and second layers/plies

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are glued together in order to form a useable return envelope, a third layer/ply above the second layer/ply contains the bill/message, a fourth layer/ply above the bill/message layer/ply combined with the first layer/ply forms the out going envelope, and a fifth layer/ply above the fourth layer/ply that forms a removable cover sheet. Where information printed/applied on/to the cover sheet is selectively vertically transferred to the appropriate locations on the second/third/fourth layers/plies by using selectively applied image transfer coatings.

4.1.2 In regard to claim 85, since one of ordinary skill would not want the mailer of either Bowen et al ('069) or Elmlinger ('082) to be destroyed by the postal processing equipment, it would have been inherent to one of ordinary skill at the time the invention was made that each of the layers/plies of either Bowen et al ('069) or Elmlinger ('082) must be made from a material that will survive any reasonably foreseeable potential damage that may be caused during process of delivering the outgoing and return mailing envelopes.

4.1.3 In regard to the line of weakness in claim 104, note line 66 as depicted in fig. 1 of Bowen et al ('069) or line 40 in fig. 1 of Elmlinger ('082).

4.2 Claims 102, 103 & 109, are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by McCoy et al (6,409,592)

4.2.1 In regard to claims 102, 103 & 109, McCoy et al ('592), discloses mailer comprises of a sheet of paper having an outside and an inside surfaces and where information is printed in one or more areas on the outside surface. While the area on the inside surface are covered by two different methods. That is the inside surface is divided into a number of areas, where a security screen is used to cover the inside surface with the exception of the areas that correspond to the areas on the outside surface on which information is printed. And wherein the areas that correspond to the areas that have information printed on the outside surface are covered by an white solid opaque medium.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

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matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claims 83, 84, 87 & 98-101 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,428,082) as applied to claims 82, 85, 91, 93, 94, 97, 104 & 112 and further in view of obvious considerations required by applicant's admitted requirements for processing mail.

5.1.1 In regard to claims 83, 84, 87 & 98 it is noted that the mailer of either Bowen et al ('069) or Elmlinger ('082) is for use in a postal system that uses various machines to aid in the process of processing and delivering mail. Since applicant admits that:

A) the Post Office requires a 90% readability of applied barcodes (see the last full paragraph of page 3);

B) the Post Office provides discounts for the application of information such as postal barcodes and facer identification marks (FIM) to items of mail (see the first full paragraph of page 2 and the paragraph bridging pages 2-3);

C) the Post Office uses optical character recognition (OCR) and barcode readers (BCR) to scan information applied to a mailing (see the paragraph bridging pages 1-2); and

D) the machines used by the Post Office to sort mail sometimes smears the applied barcodes so that the barcode is illegible, (see second full paragraph on page 1, "The present invention ... smeared by the post office processing equipment.");

it would have been obvious to one of ordinary skill at the time the invention was made that if the user of the mailer of either Bowen et al ('069) or Elmlinger ('082) were to apply barcodes

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to the out going and return envelopes to obtain a postal discount, then the applied barcodes and FIMs would be placed on the envelopes at a location which:

- A) may be read by the equipment used by the Post Office;
- B) is protected from being rendered or made useless/illegible by the equipment used by the Post Office; and
- C) has suitable contrast with the background color of the mailer so as to aid in the recognition of the barcode.

5.1.2 In regard to claims 99 & 100, it is noted that since applicant discloses that the use of FIMs reduces the associated postage costs, it would have been obvious to one of ordinary skill at the time the invention was made that the FIM applied to the out going envelope could be also applied to the return envelope using the transfer process of either Bowen et al ('069) or Elmlinger ('082).

5.1.3 In regard to claim 101, note above in regard to the teachings of either Bowen et al ('069) or Elmlinger ('082).

5.2 Claim 86 & 88-90, are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,428,082) as applied to claims 82-85, 87, 91, 93, 94, 97-101, 104 & 112 and further in view of Fabel (4,461,661).

5.2.1 In regard to claim 86, although either Bowen et al ('069) or Elmlinger ('082) does not disclose the bond of the paper used to form the various layers/plies, Fabel ('661) in the environment of making multi-ply mailers discloses a mailer composed of a number of attached layers/plies with selective carbon spotting to the multiple layers/plies in order to selectively transfer information applied to the top layer/ply to underlying layers/plies. Where Fabel ('661) further discloses that:

- A) two of the layers are combined to form the return mailing envelope;
- B) two of the layers are combined to form the outgoing mailing envelope;
- C) any suitable weight/bond of paper may be used for each layer/ply;
- D) a tear strip used to aid the recipient in opening the mailing.

5.2.2 Since each of Bowen et al ('069), Elmlinger ('082) and Fabel ('661) use similar mailers that are constructed in a similar fashion, and Fabel ('661) explicitly suggests:

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A) the need to use paper with sufficient weight/bond in order to obtain the desired result of the system of Fabel ('661); and

B) the layers/plies of the mailing are bonded together;

it would have been obvious to one of ordinary skill at the time the invention was made that a user of the mailer of either Bowen et al ('069) or Elmlinger ('082) would use any suitable bonding means and weight/bond of paper to form each layer/ply of the mailer as taught by Fabel ('661) so as to form a complete mailer that is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender.

5.2.3 In regard to claims 88-90 and the reinforcing the right edge of the mailer so as to be processed by the mail processing equipment of the post office, since the mailer of either Bowen et al ('069) or Elmlinger ('082) or Fabel ('661) must be strong enough to be processed by post office mail processing equipment without being damaged, it would have been obvious to one of ordinary skill at the time the invention was made that the leading edge of the mailer of either Bowen et al ('069) or Elmlinger ('082) or Fabel ('661), as processed by post office mail processing equipment, must be constructed/reinforced in such a fashion so as to be form a complete mailer that is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender as taught by Fabel ('661).

5.3 Claims 92, 95, 96, 105-108, 110 & 111 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,428,082) as modified by Fabel (4,461,661) as applied to claims 82-91, 93, 94, 97-101, 104 & 112 and further in view of Ashby (5,039,000) and (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

5.3.1 As per claims 92, 95, 96, 105-108, 110 & 111 and the use of a tear strip on the back of the mailer and positioned along the bottom of the mailer and that opens from the left side to the right side of the mailer. It is noted that although the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by Fabel ('661) includes the use of tear strips to aid in opening the envelope, the mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by Fabel ('661) does not include the use of a tear strip that opens from left to right and is positioned on the back side of the mailer along the lower/bottom edge of the mailer. However, Ashby ('000) does disclose a multiple layer/ply mailer that includes the use of a tear strip that opens from

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left to right and is positioned along the lower/bottom edge of the mailer in order to aid the use in opening the mailer. Since Fabel ('661) explicitly suggests using a tear strip to aid the recipient in opening the mailing, it would have been obvious to one of ordinary skill at the time the invention was made that mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by Fabel ('661) could be further modified to include the use of a tear strip that opens from left to right and is positioned along the lower/bottom edge of the mailer as taught by Ashby ('000) so that the mailer is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender.

5.3.2 In regard to the flap in claims 105-108, 110 & 111, note flap 44 as depicted in fig. 1 of Bowen et al ('069) or flap 50 as depicted in fig. 8 of Elmlinger ('082) or flap 94 as depicted in fig. 14b of Fabel ('661) or the features of the invention designated as 14, 54, 64 & 66 in fig. 4 of Ashby ('000). It is noted that all of these flaps have the same function and have been formed by sealing three of the four sides of the return envelope. Since either Bowen et al ('069) or Elmlinger ('082) or Fabel ('661) or Ashby ('000) use a flap on the return envelope in order to seal the return envelope, it would have been obvious to one of ordinary skill at the time the invention was made that the flap of either Bowen et al ('069) or Elmlinger ('082) as modified by Fabel ('661) and Ashby ('000) could be placed on any of the sides of the return envelope absent applicant showing of new and unexpected results from positioning the flap on a particular side of the return envelope, since the function of the flap does not change based on which side of the envelope that it may appear, for as the Court has stated it is not invention to merely move the location of a device, since the new position does not affect, i.e. modify the operation of the device, (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

6. The examiner has cited prior art of interest, for example:

A) Klein (1,200,735), which discloses using a tear strip located on the right/leading edge of an item of mail in order to open the item of mail.

B) Sherman (2,257,766), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers.

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C) Schumacher (3,133,752), which discloses a multi layered mailing that includes the use of an overlay/cover sheet and a carbon transfer medium to transfer information, such as the recipient's address and billing information, that has been applied to the overlay sheet to corresponding areas of previously printed lower layers of the mailing, where the layers of the mailing are glued on at least one edge and use tear strips to separate the layers.

D) either Chamberlain (3,211,469) or Steidinger (3,437,259) or Petkovsek (6,136,129), which disclose a multi layered mailing that includes the use of a carbon transfer medium to transfer information, such as the recipient's address and billing information, that has been applied to the one sheet of a mailing to corresponding areas of previously printed layers of the mailing, where the layers of the mailing are glued on at least one edge and use tear strips to separate the layers.

E) Wiessner (3,802,618) which disclose using an mailer that permits the original out going address to be reused as the return address on the return envelope.

F) Johnsen (3,837,565), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers, where some of the layers contain instructions on how to open the mailing.

G) the British Business article, which discloses all of the components of a mailing must fit together.

H) either Bendel (EP 354758 A1 or 5,161,735), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers and wherein a layer may be folded to form the mailing envelope and wherein postal barcodes are applied to the mailing envelope. Bendel (EP 354758 A1) is a family member of Bendel (5,161,735) and is cited for the same disclosure of Bendel (5,161,735).

I) either File (EP 0527588 A1) or Lombardo (5,346,123) or Mudry et al (5,598,970), which disclose the use of a folded multi-layer/ply envelope with a tear strip to aid in the separation of the various components.

J) either Chess (5,253,803 or EP 586061 A1), which discloses a mailing comprised of a number of layers/plies with selective carbon spotting to transfer information applied to the top layer to selective underlying layers and wherein two of the layers are combined to form the mailing and return envelopes. Chess (EP 586061 A1) is a family member of Chess (5,253,803) and is cited for the same disclosure of Chess (5,253,803).

7. Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2 Applicant's arguments in regard to providing high contrast areas are directed to unclaimed distinctions and merits, since the claims do not recite the use of high contrast areas.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

12/03/03


Edward R. Cosimano
Primary Examiner A.U. 3629